

REMARKS

Claims 1-37 were originally pending in the application. The claims were restricted into five groups: Group I (Claims 1-7, 31, 33-37, Compounds and compositions where X is N); Group II (Claims 1, 3-16, 31 and 37, compounds and compositions where X is CH); Group III (Claims 18-20, uses of the Group I compounds); Group IV (uses of the Group II compounds); and Group V (Claims 21-30 and 32). If electing from among Groups I-VIII, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

Applicants are puzzled by the restriction into these numerous Groups. Applicants believe that all claims 1-37 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-37 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submit that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above five

groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, in order to comply with the Examiner's requirement, the undersigned Attorney-of-Record elected during a telephone conversation with the Examiner on September 21, 2005, with traverse, the invention cited as Invention Group No. I by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant elected the compound of Example 35. This Response/Amendment affirms that election.

In accordance with that election, Applicants are canceling the non-elected invention of claims 18-30 and 32 with the understanding that the Examiner will be considering a rejoinder if and wherever found appropriate. In any case, Applicants are preserving the right to file divisional application(s) on the scope of the cancelled claims, if Applicants choose to do so.

In the instant Office Action, the Abstract was objected to. This Amendment is believed to address that objection. No new matter is introduced.

The Examiner objected to the specification stating that the "status of the US provisional case is extraneous and should be deleted." It is not clear to Applicants why the status of the provisional case is considered extraneous, since cross reference to priority application in the beginning of a non-provisional case is usually required. Applicants would sincerely appreciate a clarification from the Examiner.

Claim 37 was rejected under 35 U.S.C. §112, second paragraph. It is now cancelled. Withdrawal of the §112 rejection is, therefore, respectfully requested.

Claims 1-17, 31, 33-37 were rejected under 35 U.S.C. §112, first paragraph, for usage of the term "isomer". Applicants have now amended "isomer" to "stereoisomer" which is believed to satisfy the Examiner's concern. Support is provided on page 12, lines 6-20. Withdrawal of the §112, first paragraph, rejection is, therefore, respectfully requested.

Claims 1-17, 31, 33-37 were rejected under 35 U.S.C. §112, first paragraph, for usage of the terms "heteroaryl" and "heterocycl". This amendment defines both terms in accordance with the definitions provided on

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page 6, lines 18-20 and page 7, lines 18-20. Applicants believe that such narrowing reduces the "variation" significantly and is also commensurate with *In re Wands*. Withdrawal of the §112, first paragraph, rejection is, therefore, respectfully requested.

Claims 33-37 were objected to as being dependent on a rejected base claims. However, with the present amendment, Applicants believe that the objection is moot.

The Examiner inquired of the reason behind the proviso for R<sup>3</sup> in claim 1. The proviso was added strictly in consideration of possible chemical instability if any, and was not necessitated by any art.

Claim 2 is cancelled to avoid redundancy.

There being no other rejection pending, Applicants believe that the claims, as amended, are in allowable condition and such an action is earnestly solicited. If the Examiner has any questions, the Examiner is invited to contact the undersigned.

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Respectfully submitted,

  
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